



**Common Communication
on the Common Practice of
Distinctiveness – Figurative Marks
containing descriptive/non-distinctive words**
2 October 2015

1. BACKGROUND

The IP offices of the European Trade Mark and Design Network continue to collaborate in the context of the Convergence Programme. They have now agreed on a Common Practice in relation to when a figurative mark, containing purely descriptive/non-distinctive words, passes the absolute grounds examination because the figurative element renders sufficient distinctive character.

This Common Practice is made public through this Common Communication with the purpose of further increasing transparency, legal certainty, and predictability for the benefit of examiners and users alike.

The following issues are out of the scope of the project:

- Language issues: consider for the sake of the project that the word elements are totally descriptive/non-distinctive in your language.
- Interpretation of disclaimers: the common practice does not affect the acceptance or interpretation of disclaimers by the IP offices.
- Use of the trade mark (including acquired distinctiveness and how the mark is actually used in trade).

2. THE COMMON PRACTICE



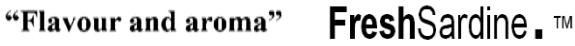
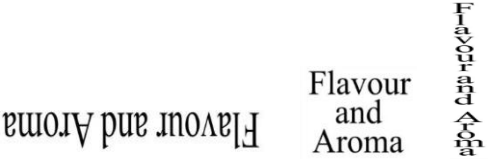
The following text summarizes the key messages and main statements of the principles of the Common Practice. The complete text can be found at the end of this Communication.

In order to determine if the threshold of distinctiveness is met due to the figurative features in the mark the following criteria are considered:

Note: The signs containing 'Flavour and aroma' seek protection for **coffee in Class 30, the signs containing 'Fresh sardine' and 'Sardines' seek protection for **sardines** in Class 29, the sign containing 'DIY' seeks protection for **kits of parts for assembly into furniture** in Class 20, the signs containing 'Pest control services' seek protection for **pest control services** in Class 37, and the sign containing 'Legal advice services' seeks protection for **legal services** in Class 45.*

WITH RESPECT TO THE WORD ELEMENTS IN THE MARK

Criterion	Typeface and font
Common Practice	<ul style="list-style-type: none"> • In general, descriptive/non-distinctive word elements appearing in basic/standard typeface, lettering or handwritten style typefaces – with or without font effects (bold, italics) – are not registrable. <p><u>Non-distinctive examples:</u></p> <p>Fresh Sardine <i>Fresh Sardine</i> FrEsh SaRdine</p> <p><i>Flavour and aroma</i> <i>Flavour and aroma</i> <i>Flavour and aroma</i></p>

	<ul style="list-style-type: none"> Where standard typefaces incorporate elements of graphic design as part of the lettering, those elements need to have sufficient impact on the mark as a whole to render it distinctive. When these elements are sufficient to distract the attention of the consumer from the descriptive meaning of the word element or likely to create a lasting impression of the mark, the mark is registrable. <p><u>Distinctive examples:</u></p> 
<p>Criterion</p> <p>Common Practice</p>	<p><i>Combination with colour</i></p> <ul style="list-style-type: none"> The mere 'addition' of a single colour to a descriptive/non-distinctive word element, either to the letters themselves or as a background, will not be sufficient to give the mark distinctive character. Use of colours is common in trade and would not be seen as a badge of origin. However, it cannot be excluded that a particular arrangement of colours, which is unusual and can be easily remembered by the relevant consumer, could render a mark distinctive. <p><u>Non-distinctive examples:</u></p> 
<p>Criterion</p> <p>Common Practice</p>	<p><i>Combination with punctuation marks and other symbols</i></p> <ul style="list-style-type: none"> In general, the addition of punctuation marks or other symbols commonly used in trade does not add distinctive character to a sign consisting of descriptive/non-distinctive word elements. <p><u>Non-distinctive examples:</u></p> 
<p>Criterion</p> <p>Common Practice</p>	<p><i>Position of the word elements (sideways, upside-down, etc.)</i></p> <ul style="list-style-type: none"> In general, the fact that the word elements are arranged in vertical, upside-down or in one or more lines is not sufficient to endow the sign with the minimum degree of distinctive character that is necessary for registration. <p><u>Non-distinctive examples:</u></p>  <ul style="list-style-type: none"> However the way in which the word elements are positioned can add distinctive character to a sign when the arrangement is of such a nature that the average consumer focuses on it rather than immediately perceiving the descriptive message.

Distinctive examples:

And
r
Flavour
m
a

F l a v o u r
d n a m e

WITH RESPECT TO THE FIGURATIVE ELEMENTS IN THE MARK

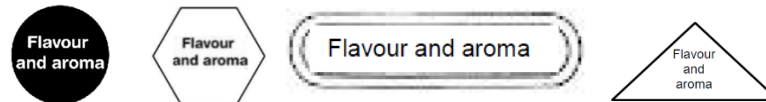
Criterion

Use of simple geometric shapes

Common Practice

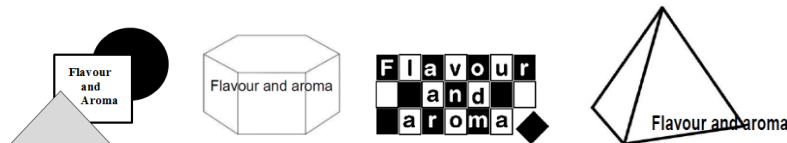
- Descriptive or non-distinctive verbal elements combined with simple geometric shapes such as points, lines, line segments, circles, triangles, squares, rectangles, parallelograms, pentagons, hexagons, trapezia and ellipses are unlikely to be acceptable, in particular when the above mentioned shapes are used as a frame or border.

Non-distinctive examples:



- On the other hand, geometric shapes can add distinctiveness to a sign when their presentation, configuration or combination with other elements creates a global impression which is sufficiently distinctive.

Distinctive examples:



Criterion

The position and proportion (size) of the figurative element in relation to the word element

Common Practice

- In general, when a figurative element that is distinctive on its own is added to a descriptive and/or non-distinctive word element, then the mark is registrable, provided that said figurative element is, due to its size and position, clearly recognizable in the sign.

Non-distinctive examples:

Flavour and aroma *Fresh Sardine*

Distinctive example:



Criterion

Whether the figurative element is a representation of, or has direct link with, the goods and/or services

Common Practice

- A figurative element is considered to be descriptive and/or devoid of distinctive character whenever:

- It is a true-to-life portrayal of the goods and services.
- It consists of a symbolic/stylised portrayal of the goods and services that does not depart significantly from the common representation of said goods and services.

Non-distinctive examples:



Distinctive examples:




- A figurative element which does not represent the goods and services but has a direct link with the characteristics of the goods and services will not render the sign distinctive, unless it is sufficiently stylised.

Non-distinctive example:



Distinctive example:



Criterion	<i>Whether the figurative element is commonly used in trade in relation to the goods and/or services applied for</i>
Common Practice	<ul style="list-style-type: none"> • In general, figurative elements that are commonly used or customary in trade in relation to the goods and/or services claimed do not add distinctive character to the mark as a whole. <p><u>Non-distinctive examples:</u></p> 

WITH RESPECT TO BOTH THE WORD AND FIGURATIVE ELEMENTS IN THE MARK

	<i>How combinations of the criteria affect distinctiveness</i>
Common Practice	<ul style="list-style-type: none"> • In general, a combination of figurative elements and word elements, which if considered individually are devoid of distinctive character, does not give rise to a distinctive mark. • Nevertheless, a combination of such elements when considered as a whole could be perceived as a badge of origin due to the presentation and composition of the sign. This will be the case when the combination results in an overall impression which is sufficiently far removed from the descriptive/non-distinctive message conveyed by the word element. <p><u>Examples:</u> In order for a sign to be registrable, it must have a minimum level of distinctiveness. The purpose of the scale is to illustrate where that threshold is. The</p>

examples below from left to right contain elements with an increasing impact on the distinctiveness of the marks, resulting in marks which are either non-distinctive in their totality (red column) or distinctive in their totality (green column).

Non-distinctive	Distinctive
<p>1.</p>	
<p>2.</p>	
<p>3.</p>	

It should be noted that an applicant will not obtain exclusive rights on descriptive/non-distinctive words, when it is the figurative element that renders the mark distinctive as a whole. The scope of protection is limited to the overall composition of the mark. For the impact on the scope of protection when a mark consists of non-distinctive/weak elements please see the Principles of the Common Practice on CP5. Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components).

https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_ohim/who_we_are/common_communication/common_communication5_en.pdf

3. IMPLEMENTATION

As has been the case with previous common practices, the Common Practice will take effect within three months of the date of publication of this Common Communication.

Further details on the implementation of this Common Practice are available in the table below.

Implementing offices may choose to publish additional information on their websites.

At the time of writing, the following offices will implement the common practice: AT, BG, BOIP, CY, CZ, DE, DK, EE, ES, FR, GR, HR, HU, IE, LT, LV, MT, NO, OHIM, PT, RO, SE, SI, SK, UK.

The following EU offices support the common practice, but will not implement it at this moment in time: FI, IT, PL.

3.1 IMPLEMENTING OFFICES

LIST OF IMPLEMENTING OFFICES, IMPLEMENTATION DATE AND IMPLEMENTATION PRACTICE

Overview of implementation of the Common Practice						
Office	Implementation date	The Common Practice will be applicable to:				
		<u>Applications pending on the implementation date</u>	<u>Applications filed after the implementation date</u>	<u>Invalidity proceedings pending on the implementation date</u>	<u>Invalidity proceedings filed after the implementation date</u>	<u>Requests for invalidity of TMs which were examined under this common practice</u>
AT	02.01.2016		X			
BG	02.01.2016	X	X	X	X	X
BOIP	02.10.2015	X	X	N/A	N/A	N/A
CY	02.10.2015		X		X	X
CZ	02.01.2016		X			X
DE	02.10.2015	X	X			X
DK	01.01.2016		X			X
EE	01.01.2016		X	N/A	N/A	N/A

ES	02.01.2016		X	N/A	N/A	N/A
FR	02.10.2015	X	X	N/A	N/A	N/A
GR	02.10.2015		X			X
HR	01.01.2016	X	X		X	
HU	01.12.2015		X		X	
IE	02.01.2016		X			X
LT	01.01.2016		X	N/A	N/A	N/A
LV	02.01.2016		X			X
MT	02.10.2015	X	X	N/A	N/A	N/A
NO	02.10.2015	X	X	X	X	X
OHIM	02.01.2016	X	X	X	X	X
PT	03.10.2015	X	X	N/A	N/A	N/A
RO	02.01.2016	X	X	N/A	N/A	N/A
SE	02.10.2015	X	X	N/A	N/A	N/A
SI	02.01.2016		X	N/A	N/A	N/A
SK	01.12.2015	X	X	X	X	X
UK	02.10.2015		X		X	

N/A: NOT APPLICABLE

ANNEX:

PRINCIPLES OF THE COMMON PRACTICE